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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,721	06/29/2000	Gordon C. Cheng	CC8128-DRIB	7493

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EXAMINER

KIDWELL, MICHELLE M

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 05/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/606,721		CHENG ET AL.	
	Examiner :		Art Unit	
	Michele Kidwell		3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10,11,19,22,26,35-38,43,45-49,56,79-85 and 91-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) -2,4-8,10-11,19,22,26,35-38,43,45-49,56,79-85 and 91-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 44, 69 – 78 and 95 – 96 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 3.

Claims 61 and 65 – 68 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 3.

The examiner notes the applicant's assertion that figures 2A and 2B present the same system as presented in figure 1 and contends that Species 1, as elected by the applicant, consists of figures 1, 2A and 2B.

Claim 3 (and its dependents) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 3 discloses a storage-conveyance connector as shown in figure 4, which is a nonelected species.

Claim 9 (and its dependents) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 9 discloses a means for expanding the compression tube as shown in figure 8D, which is a nonelected species.

Claim 23 (and its dependents) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 23 discloses a slitted sheath tube having left and right slit flaps and a means for securing the left slit flap to the right slit flap as shown in figure 12, which is a nonelected species.

Claim 26 (and its dependents) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 26 discloses a ring of expandable tubing that is fixedly connected to the sheath tube as shown in figure 7A, which is a nonelected species.

Claim 29 (and its dependents) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 29 discloses a sheath tube comprising a rigid plastic bellows as shown in figure 15, which is a nonelected species.

Claim 31 (and its dependents) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 31 discloses a spring expandable to fit the penis shaft and a toothed plastic strap disposed within the spring wherein the spring/strap combination is removably connected to the sheath as shown in figure 16, which is a nonelected species.

Claim 33 (and its dependents) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 33 discloses a hand rest and an expandable jaw ring as shown in figure 17, which is a nonelected species.

Claim 39 (and its dependents) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 39 discloses a means for directing and absorbing urine as shown in figure 4B, which is a nonelected species.

Claim 41 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 41 discloses straps connected to the means for storage as shown in figure 5A, which is a nonelected species.

Claim 42 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 4 discloses a means for mounting as shown in figure 5A, which is a nonelected species.

Claim 50 (and its dependents) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 50 discloses a means for expanding the compression tube as shown in figure 8D, which is a nonelected species.

Claim 54 (and its dependents) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 54 discloses a slitted sheath tube having left and right slit flaps and a means for securing the left slit flap to the right slit flap as shown in figure 12, which is a nonelected species.

Claim 57 (and its dependents) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 57 discloses a ring of expandable tubing that is fixedly connected to the sheath tube as shown in figure 7A, which is a nonelected species.

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Claim 59 (and its dependents) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 59 discloses a sheath tube comprising a rigid plastic bellows as shown in figure 15, which is a nonelected species.

Claim 60 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 60 discloses a spring expandable to fit the penis shaft and a toothed plastic strap disposed within the spring wherein the spring/strap combination is removably connected to the sheath as shown in figure 16, which is a nonelected species.

Claim 62 (and its dependents) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 62 discloses a compression tube comprising a means for expansion as shown in figure 8D, which is a nonelected species.

Claim 86 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 86 discloses a divided inner cavity of the storage container as shown in figure 5A, which is a nonelected species.

Claim 87 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 87 discloses a means for storage further comprising absorbent material as shown in figure 5A, which is a nonelected species.

Claim 88 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 86 discloses a means for distributing urine as shown in figure 5A, which is a nonelected species.

Claim 89 (and its dependents) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Claim 89 discloses a means for attaching the storage container to the human male as shown in figure 5A, which is a nonelected species.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because:

- Reference character "60" has been used to designate a connection mechanism, a wicking interconnection and a system connection
- Reference character "70" has been used to designate a connection mechanism, a wicking interconnection and a system connection.
- Reference character "260" has been used to designate a wicking transport means, a collector wicking spacer and a wicking spacer
- Reference character "106" has been used to designate a wicking transport means, a conveyance wicking spacer and a wicking spacer
- Reference character "340" has been used to designate a wicking transport means, a wicking spacer, a storage wicking spacer and a wicking spacer piece

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- Reference character "290" has been used to designate a collector – conveyance connector and a connection

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Reference characters "1041" and "1042" as shown in figure 2B. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1 – 2, 4 – 8, 10 – 11, 19, 22, 26, 35 – 38, 43 and are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "said means for conveyance" in line 11. There is insufficient antecedent basis for this limitation in the claim. With respect to this claim, it is unclear if the applicant intends to claim both a means for conveyance and a separate means for conveying or if the means for conveying and the means for conveyance are both one and the same element. Clarification is required.

Claim 2 recites the following limitations:

- "means for conveyance" in lines 9 and 10
- "first means for collection" in line 9
- "second means for collection" in line 11
- "said storage device" in line 10

There is insufficient antecedent basis for these limitations in the claim.

Claim 4 recites the limitation "said second wicking spacer piece" in line 9.

There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the following limitations:

- "first means for collecting" in lines 3 – 4
- "second means for collecting" in line 4

There is insufficient antecedent basis for these limitations in the claim.

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Regarding claim 7, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention.

See MPEP § 2173.05(d).

Claim 8 recites the limitation "said penis" in lines 2, 4 and 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the slippage" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "said collection device" in lines 4 – 5. There is insufficient antecedent basis for this limitation in the claim. Additionally, it is unclear what thin-wall PE "lay –flat" tubing is. The applicant should provide a complete name for the acronym provided.

Claim 22 recites the limitation "said interior surface" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 26 recites the limitation "said penis" in lines 2 – 7. There is insufficient antecedent basis for this limitation in the claim. Additionally, the applicant claims that the sheath tube has a tube cavity sufficiently large to surround the penis and an opening radial edge. It is unclear what constitutes an opening radial edge and how an opening radial edge can be surrounded by a sheath tube.

Claim 35 recites the limitation "said penis" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 36 recites the limitation "said surface" in line 4. There is insufficient antecedent basis for this limitation in the claim.

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Claim 46 recites the limitation "the slippage" in lines 2 – 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 47 recites the limitation "the slippage" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 48 recites the limitation "said collection device" in line 5. There is insufficient antecedent basis for this limitation in the claim. Additionally, it is unclear what thin-wall PE "lay –flat" tubing is. The applicant should provide a complete name for the acronym provided.

Regarding claim 49, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Regarding claim 80, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 92 recites the limitation "the material" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1 – 2, 4 – 8, 10 – 11, 26, 35, 43, 45 – 49, 56, 79 – 80, 83, 85, 91 and 93 are rejected under 35 U.S.C. 102(b) as being anticipated by Rogers, III et al. (US 3,835,857).

With respect to claim 1, Rogers, III et al. (hereinafter "Rogers") disclose a system for collecting, conveying and storing urine discharged from a human male comprising means for collection of the urine from the human male comprising proximal and distal ends and outer and inner surfaces (11), means for storage of the urine before disposal of the urine comprising proximal and distal ends and outer and inner surfaces (24), means for conveying the urine from the means for collection of the urine to the means for storage of the urine comprising proximal and distal ends and outer and inner surfaces (23) and means for wicking the urine away from the human male wherein the means for wicking moves said urine away from the human male through said means for collection and said means for conveyance, and deposits said urine in said means for storage as set forth in col. 5, line 62 to col. 6, line 3.

As to claim 2, Rogers teaches a system further comprising first means of connection which connects the means for collection and the means for conveying and which comprising an outer surface and an inner surface (21), second means of connection which connects said means for conveying and said means for storage and which comprises an outer surface and an inner surface (22), wherein the first means of connection is selected from the group consisting of fixed and removable, and said second means of connection is selected from a group consisting of fixed and removable, and wherein the distal end of the means for collection is connected to the

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proximal end of the means for conveyance through the first means for collection, and said distal end of the means for conveyance is connected to the proximal end of the storage device through said second means for connection as set forth in col. 5, line 25 to col. 6, line 3 and figure 1.

Regarding claim 4, Rogers discloses a system wherein the means for wicking comprises a first wicking spacer disposed within the means for collection (col. 5, lines 12 – 24), a second wicking spaced disposed within the means for conveying (col. 3, lines 11 – 52), a third wicking spacer disposed within said means for storage of aid urine (col. 6, lines 49 – 68), first wicking spacer piece forming contiguous wicking connections between the first wicking spacer and the second wicking spacer (col. 5, lines 45 – 49), and second wicker spacing piece forming contiguous wicking connections between said second wicking spacer and said third wicking spacer (col. 3, line 63 to col. 4, line 5 and figure 4), wherein the first wicking spacer, said first wicking spacer piece, said second wicking spacer, said second wicker spacer pieced and said third wicking spacer collectively form a complete wicking path from the means for collection to the means for storage as set forth in col. 5, line 66 to col. 6, line 3 and col. 6, lines 66 – 68).

With reference to claims 5 – 6, see col. 3, lines 7 – 9.

As to claims 7 and 49, see col. 3, lines 7 – 9 and col. 5, lines 9 – 17.

With respect to claim 8, Rogers discloses a system wherein the means for collection comprises means for wicking the urine away from the penis, a thin-wall hollow conduction tube having proximal and distal ends and a cavity sufficiently large to surround the penis (11) and a compression tube having proximal and distal ends and

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sufficient size to be disposed around and provide radial compression contact upon said penis at the proximal end of the conduction tube (col. 4, lines 40 – 66), wherein the means for wicking is disposed within the conduction tube as set forth in col. 5, lines 12 – 20 and figures 1 and 4.

Regarding claim 10, see col. 4, lines 40 – 66.

As to claims 11 and 48, see col. 3, lines 7 – 9.

With reference to claims 26 and 56, see col. 4, lines 2 – 66, col. 5, lines 12 – 24 and figure 1.

Regarding claim 35, Rogers discloses a system wherein the means for conveyance comprises a waterproof conveyance tube film layer (11), a conveyance tube having an exterior surface upon which the waterproof conveyance tube film layer is disposed and a hollow interior into which the penis is placed (43), means for wicking the urine through the conveyance tube wherein the means for wicking prevents the interior of the conveyance tube from becoming blocked when crimped or kinked wherein the means for wicking is disposed within the conveyance tube film layer and the combination of the means for wicking with the film layer is sufficiently flexible to conform to normal bodily movement and position as set forth in col. 3, lines 11 – 62.

As to claim 43, see col. 3, lines 9 – 11.

Regarding claims 45 – 47, see the rejection of claims 4 and 8.

With reference to claim 79, see col. 3, lines 9 – 11, col. 5, lines 12 – 24 and figure 1.

As to claim 80, see col. 3, lines 7 – 9.

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With respect to claim 83, see col. 5, lines 12 – 24.

Regarding claim 85, see col. 6, lines 48 – 68.

Regarding claim 91, see figure 1.

As to claim 92, the examiner contends that any article capable of being thrown away, including two sheets of flexible material as disclosed by Rogers, is considered to be disposable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 22, 36 – 38, 81 – 82, 84, 92 and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers, III et al. (US 3,835,857).

The difference between Rogers and claim 19 is the provision that the first wicking spacer is located between the penis tip and the first means of connection. Rogers teaches the first wicking spacer to be disposed within the means for collection between the penis and the first means for collection. It would have been obvious to one of ordinary skill in the art to modify the first wicking spacer to Rogers to provide the first wicking spacer between the penis tip and the first means of connection since it has been held that rearranging parts of an invention involves only routine skill in the art.

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The difference between Rogers and claim 22 is the provision that the first wicking spacer comprise a y-shape having a tail and two legs such that the legs of the y-shape lie in proximity to the interior surface of the means for collection. Rogers discloses a first wicking spacer that is formed within the inner surface of the conduction tube (col. 5, lines 12 – 24), thereby providing effective contact with the inner surface of the conduction tube. The applicant discloses on page 79 of the specification that the purpose of providing a y-shaped wicking spacer is the enable more effective contact with the inner surface of the conduction tube. Since the wicking spacer of Roger serves the same purpose, it is inherent that the wicking spacer of Rogers will yield the same results as the wicking spacer of the claimed invention.

With respect to claims 36 – 38, 81 – 82, 84, 92 and 94, absent of a critical teaching and/or unexpected result, the examiner contends that the claimed limitations are an obvious matter of design choice that do not patentably distinguish the claimed invention from the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 703-305-2941. The examiner can normally be reached on Monday - Friday, 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dennis Ruhl can be reached on 703-308-2262. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-305-3590 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Michele Kidwell

Michele Kidwell
May 20, 2002

Aaron J. Lewis

Aaron J. Lewis
Primary Examiner